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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,310	07/18/2003	Peter Louis Gebrian	DCS-9178	3469

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DADE BEHRING INC.
LEGAL DEPARTMENT
1717 DEERFIELD ROAD
DEERFIELD, IL 60015

EXAMINER

CROSS, LATOYA I

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/623,310

Applicant(s)

GEBRIAN ET AL.

Examiner

LaToya I. Cross

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11-6-03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

Pages 9, 11 and 13 of the specification are incomplete, as they are missing information. It appears that Applicants intend to reference other patent applications. It is suggested that Applicants use the patent application publication numbers, instead of the application serial numbers, where possible.

Claim Rejections - 35 USC § 112

1. Claims 2 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2-6 attempt to further define the loading tray, reagent server and reagent carousel. However, neither of these limitations has been positively recited in independent claim 1. Claim 1 makes reference to the loading tray, reagent server and reagent carousel in the context of the how the shuttle operates. However, such mentioning is not a positive recitation of the components. Applicants should amend claim 1 to positively recite the presence of the loading tray, reagent server and reagent carousel.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

Art Unit: 1743

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by US patent 6,571,934 to Thompson et al.

Thompson et al teach a system for bi-directional shuttling cuvettes throughout an analyzer. The system comprises a single bi-directional linear device transport mechanism (90LT) that includes a single input-output lane (72/74) formed along the operating surface. See figure 3. At col. 8, lines 55-58, Thompson et al teach that after liquid is aspirated into the sample tube rack (42), a shuttle mechanism positions the sample rack onto the bi-directional transport lane, as recited in claim 2. The reference also teaches a shuttle mechanism (80, 80A), sample tube rack (42) and buffer zone (84) for storing the sample tube rack, as recited in claim 3. With respect to claim 4, Thompson et al teach concentric carousels having an outer carousel (14) and an inner carousel (16). Shuttle mechanism (80) serves a first transfer device, while shuttle mechanism (80A) serves as a second transfer device. Thompson et al further teach a reaction carousel (12) having reaction vessels (19), as recited in claim 6 (col. 7, lines 1-3).

It is noted that Applicants refer to "reagent" container and carousel, while Thompson et al teach a "cuvette" carousel. However, Thompson et al teach that the cuvettes carousels contain reagent and sample (col. 6, lines 1-17). Thus, absent some express difference between the reagent carousel claimed and those taught by Thompson et al, the reference reads on the claimed invention.

4. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by US patent 6,723,288 to Devlin et al.

Art Unit: 1743

Devlin et al teach a single bi-directional shuttle (68) for moving sample racks or other similar devices at a single time in between analyzers (10, 11). Devlin et al teach that the shuttle (68) provides for total random-access movement of sample racks without the restriction of freedom of movement of prior art mechanisms (col. 10, lines 2-5). As a part of the analyzers, the reference teaches a fluid sampling arm (44), sample tube storage racks (42) and environmental chamber (38) for storing the tubes for an amount of time. There exist an outer cuvette carousel (14) and inner cuvette carousel (16) in the analyzer. Devlin et al further teach a first rack transfer device (72) and a second rack transfer device (74), as recited in claims 5-6 (col. 9, lines 42-48). A reaction carousel (12) is also taught, having cuvette ports (20, 22).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1 and 7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,723,288. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are broader in all respect than the claim of '288 patent. Claim 1 of the instant application requires only the presence of a single bi-directional linear

Art Unit: 1743


shuttle. Claim 1 of the '288 patent recites a bi-directional shuttle transport system. Thus, the claims of the '288 are fully encompassed by the claims of the instant invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is 571-272-1256. The examiner can normally be reached on Monday-Friday 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Jill Warden
Supervisory Patent Examiner
Technology Center 1700